

**REMARKS**

The Office Action mailed June 21, 2006, has been received and reviewed. Claims 1 through 21 were pending in the application. Claims 1-8, 10-17, and 19-21 stand rejected. Claims 9 and 18 have been objected to as being dependent upon rejected base claims, but the indication of allowable subject matter in such claims is noted with appreciation. Applicants have cancelled claims 1, 2, 10, and 11. Applicant has amended claims 3-9, 12-19, and 21, and respectfully request reconsideration of the application as amended herein.

**Objections to Claims 9 and 18/Allowable Subject Matter**

Claims 9 and 18 stand objected to as being dependent upon rejected base claims, but are indicated to contain allowable subject matter and would be allowable if placed in appropriate independent form.

Applicants have amended claims 9 and 18 into appropriate independent form to include claim limitations of the respective base claims and any intervening claims. Specifically, claim 9 has been amended to include the claim limitations of independent claim 1 (now cancelled) and intervening claim 2 (now cancelled). Claim 18 has been amended to include the claim limitations of independent claim 10 (now cancelled) and intervening claims 11 (now cancelled).

**35 U.S.C. § 103(a) Obviousness Rejections**

Obviousness Rejection Based on U.S. Patent No. 6,301,701 to Walker et al. in view of U.S. Publication No. 2003/0229825 to Barry et al.

Claims 1 through 8, 10 through 17, and 19 through 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker et al. (U.S. Patent No. 6,301,701) in view of Barry et al. (U.S. Publication No. 2003/0229825). Applicant respectfully traverses this rejection, as hereinafter set forth.

**Claims 1, 2, 10, 11**

Claims 1, 2, 10, and 11 have been cancelled.

**Claims 3-8**

The nonobviousness of now-independent claim 9 precludes a rejection of claims 3-8 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. The Examiner has stated that now-independent claim 9 is allowable. Therefore, the Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejections to claims 3-8 which depend from allowable and now-independent claim 9.

**Claims 12-17**

The nonobviousness of now-independent claim 18 precludes a rejection of claims 12-17 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. The Examiner has stated that now-independent claim 18 is allowable. Therefore, the Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejections to claims 12-17 which depend from allowable and now-independent claim 18.

**Claims 19-20**

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The 35 U.S.C. § 103(a) obviousness rejections of claims 19 and 20 are improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations.

Applicants have amended independent claim 19, from which claim 20 depends, to include claim limitations similar to objected-to but allowable claims 9 and 18. Specifically, Applicants have amended independent claim 19 to recite:

19. An ordered regression test system, comprising:
- a test case database including a plurality of candidate test cases, each one of said plurality of candidate test cases including a result record including test results from testing said one of said plurality of test cases against a design model;
  - a test case ordering process to select said ordered test cases from said plurality of candidate test cases according to said test results in said result record of said each of said plurality of candidate test cases comprises:
    - excluding noninsightful ones of said plurality of candidate test cases from said ordered test cases; and*
    - preferentially ordering remaining ones of said plurality of candidate test cases to form ordered test cases comprises:*
      - dividing said remaining ones of said plurality of candidate test cases into shorter execution ones and longer execution ones;*
      - separately ordering said shorter execution ones into shorter-execution ordered test cases and said longer execution ones into longer-execution ordered test cases; and*
      - interleaving said shorter-execution ordered test cases and said longer-execution ordered test cases to form ordered test cases;*
  - a current design model to undergo regression testing; and
  - one or more testers for testing said ordered test cases against a current design model and generating new test results to update said result record. (Emphasis added.)

The Office Action states that the claim limitations of claims 9 and 18 are allowable and therefore are not taught or suggested in the Walker reference or the Barry reference. Therefore, since neither the Walker reference nor the Barry reference teach or suggest such claim limitations, these references, either individually or in any proper combination, cannot render obvious, under 35 U.S.C. §103, Applicants' invention as presently claimed in amended independent claim 19. Accordingly, Applicants respectfully request the rejection of presently amended independent claim 19 be withdrawn.

The nonobviousness of independent claim 19 precludes a rejection of claim 20 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, the Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 19 and claim 20 which depends therefrom.

**Claim 21**

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The 35 U.S.C. § 103(a) obviousness rejections of claim 21 is improper because the elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claim limitations.

Applicants have amended independent claim 21 to include claim limitations similar to objected-to but allowable claims 9 and 18. Specifically, Applicants have amended independent claim 21 to recite:

21. An ordered regression test system, comprising:
- means for assigning a result record to each of a plurality of candidate test cases, said result record including test results from testing said each of said plurality of candidate test cases against a design model;
  - means for selecting said ordered test cases from said plurality of candidate test cases according to said test results in said result record of said each of said plurality of candidate test cases, *wherein said means for selecting said ordered test cases comprises:*
    - means for excluding noninsightful ones of said plurality of candidate test cases from said ordered test cases; and*
    - means for preferentially ordering remaining ones of said plurality of candidate test cases to form ordered test cases comprises:*
      - means for dividing said remaining ones of said plurality of candidate test cases into shorter execution ones and longer execution ones;*
      - means for separately ordering said shorter execution ones into shorter-execution ordered test cases and said longer execution ones into longer-execution ordered test cases; and*

*means for interleaving said shorter-execution ordered test cases and said longer-execution ordered test cases to form ordered test cases;*

means for testing said ordered test cases against a current design model; and

means for updating said result record of said ordered test cases in response to new test results from said testing. (Emphasis added.)

The Office Action states that the claim limitations of claims 9 and 18 are allowable and therefore are not taught or suggested in the Walker reference or the Barry reference. Therefore, since neither the Walker reference nor the Barry reference teach or suggest such claim limitations, these references, either individually or in any proper combination, cannot render obvious, under 35 U.S.C. §103, Applicants' invention as presently claimed in amended independent claim 21. Accordingly, Applicants respectfully request the rejection of presently amended independent claim 21 be withdrawn.

**CONCLUSION**

Claims 3-9, 12-21 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,



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